

DOCKET NO: 275913US6RE

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
JUN YONEMITSU, ET AL. : EXAMINER: BAKER, S.
SERIAL NO: 09/522,786 :
FILED: MARCH 7, 2000 : GROUP ART UNIT: 2112
FOR: OPTICAL DISK HAVING A :
PARTICULAR FORMAT TO STORE
USER-SELECTED DATA, SUCH AS
VIDEO DATA OR COMPUTER FILES,
INCLUDING A DEDICATED TOC
REGION

PETITION UNDER 37 C.F.R. §1.183 TO

WAIVE THE REQUIREMENTS OF 37 C.F.R. §1.64

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Office Action dated July 21, 2010, please consider the following remarks.

Remarks begin on page 2 of this paper.

REQUEST

Petitioners respectfully request that the Commissioner waive the requirements under 37 C.F.R. §1.64 that each of the actual inventors execute a supplemental oath or declaration. This petition is made in light of the July 10, 2010 Petition Decision, which dismissed an earlier petition filed on January 28, 2010, and in light of the additional factual basis provided in Koichi Wada's second Declaration filed herewith.

DISCUSSION

An originally named inventor, Ryuichi Iwamura, originally signed a declaration for the present reissue application, but cannot now be found to sign a supplemental reissue declaration. Applicants filed a response on January 28, 2010, including the Declaration of Koichi Wada (First WADA declaration), which the Office considered as a petition under 37 C.F.R. §1.183 to waive the requirements of 37 C.F.R. §1.64. The Office ultimately dismissed the Petition for failing to meet the particularity requirements with regard to 37 C.F.R. §1.183.

In light of this dismissed petition, Applicants have performed a more exhaustive search to locate Mr. Iwamura and documented their efforts, consistent with the guidance provided in the July 8, 2010 petition decision, as well as the undersigned's conversation with Mr. Carl Friedman on August 12, 2010.

Included herewith is a second declaration from Koichi Wada (Second WADA declaration), explaining further efforts made after receiving the Petition Decision in an attempt to contact Mr. Iwamura. These further efforts have been made supplemental to the earlier efforts outlined in the First WADA declaration, dated September 11, 2009.

In the statement of facts provided in the Second WADA declaration, Applicants diligently attempted to once again contact Mr. Iwamura at the last known address contained in Applicants' employment records (Second WADA declaration ¶ 3). The last known address of Mr. Iwamura according to Applicants' employment records is Mr. Ryuichi

Iwamura, 11864 Paseo Lucido #2038, San Diego, California 92128 USA, phone number 1-858-673-4660 (Second WADA declaration ¶ 3).

Applicants sent a package to Mr. Iwamura (Second WADA declaration ¶ 6), as is evidenced from the enclosed Federal Express receipt dated August 25, 2010 (Exhibit I). The Federal Express envelope was addressed to Mr. Iwamura at the above-cited address.

Ultimately this package, which contained the application with current claims and supplemental declaration to be signed by Mr. Iwamura, was ultimately returned by Federal Express as is evident from the “delivery” exceptions cited in the Federal Express receipt (Second WADA declaration ¶ 6). In particular, deliveries were attempted on August 26th, 27th and the package was then ultimately returned to Mr. Wada on August 31, 2010, indicating that the recipient has moved.

In a further attempt to contact Mr. Iwamura, Mr. Wada and his staff attempted to identify the location of Mr. Iwamura by performing an Internet search dated September 1, 2010, but could not find any information regarding Mr. Iwamura’s present whereabouts (Second WADA declaration ¶ 4).

Mr. Wada and Ms. Nurishi also performed a search using telephone company Yellow Pages and White Pages on September 1, 2010, but could not find any evidence of Mr. Iwamura in or about the San Diego, California area, or otherwise (Second WADA declaration ¶ 3).

As indicated in Mr. Wada’s first declaration (first WADA declaration), multiple attempts were made on June 24, 2009 and July 22, 2009 to contact Mr. Iwamura by email. Another attempt was made by telephone on July 31, 2009. Mr. Wada explains that all of these attempts were unsuccessful and provided no further leads.

Therefore, the issue at hand is the acceptance of a reissue application by the USPTO, where all inventors but Mr. Iwamura have executed the supplemental declaration. This is the

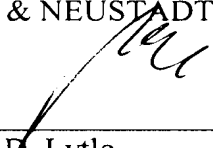
last remaining issue in this application and because Applicants have made a diligent, renewed effort to contact Mr. Iwamura, Applicants are convinced that any future efforts to contact Mr. Iwamura would be futile. Therefore, Petitioners respectfully request that the USPTO accept the reissue declaration by the inventors executed by all the inventors except for Mr. Iwamura, who could not be located after diligent and multiple efforts by Mr. Wada and others at the assignee.

Respectfully submitted,

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